

**IN THE MATTER OF AN OPPOSITION by
Vancouver Organizing Committee for the 2010
Olympic and Paralympic Winter Games to
Application No. 1238760 for the Trade-mark
ECO-TOURISM 2010 filed by Chad
Bester**

I The Pleadings

[1] On November 29, 2004, Chad Bester (the “Applicant”) filed an application to register the trade-mark ECO-TOURISM 2010 (the “Mark”) in association with the following wares and services:

- (1) Clothing, namely shirts and shorts, mugs. (2) Lighters, pens, pencils, umbrellas, hot dog sticks, whistles, flash lights, coolers, tents, back packs, cooking utensils, hiking boots, maps, books, ball caps, gloves, axes, cooking grills, key chains, post cards and first aid kits (the “Wares”); and in association with
- (1) Canoe and hiking tours; eco-tourism industry consultation and coordination towards developing eco-tourism related infrastructure projects, namely scenic trails and campgrounds. (2) Eco-tourism co-op marketing for small eco-tourism operators sharing resources to jointly market eco-tourism services. (3) Travel agency; operation of a website, namely leasing access time to a computer database in the field of eco-tourism services available in Northern BC; providing information on a website concerning eco-tourism business start-up and financing; providing information on a website concerning job listing for the eco-tourism industry; providing certification services in the field of eco-tourism facilities (the “Services”).

[2] The application is based on use in CANADA since June 01, 2003 on Wares (1) and on Services (1); use in CANADA since July 01, 2004 on Services (2); and on proposed use in

CANADA on Wares (2) and on Services (3). The Applicant has disclaimed the exclusive use of “eco-tourism” apart from the Mark as a whole.

[3] The application was advertised on December 7, 2005 in the Trade-marks Journal, for opposition purposes. Vancouver Organizing Committee for the 2010 Olympic and Paralympic Winter Games (the “Opponent”) filed a statement of opposition on May 4, 2006. The Applicant filed a counter statement on June 27, 2006 that contained, beside denials of the grounds of opposition, arguments and allegations which will be disregarded for the purpose of this decision. Evidence must be filed by way of affidavit or statutory declaration [see rules 41 to 43 inclusive of the Trade-marks Regulations] and written argument must be filed after the evidence stage is closed [see rule 46].

[4] The Opponent filed the affidavit of Dorothy Byrne, Q.C. while the Applicant filed the affidavit of Chad Bester. Neither party filed written arguments nor requested an oral hearing.

II The Grounds of Opposition

[5] The Opponent pleads that:

- 1) The Mark is not registrable pursuant to s. 12(1)(e) of the Trade-marks Act R.S.C. 1985, c. T-13 (the “Act”) in that it is a mark the adoption of which is prohibited by s. 9(1) of the Act, and specifically, the section 9 marks which have been adopted and used by the Opponent as official marks for wares and/or services in respect of which the Registrar has given public notice of their adoption, the list of which appearing in Schedule A annexed to this decision (collectively referred to as “the Opponent Official Marks”);
- 2) The Mark is not registrable pursuant to s. 12(1)(e) of the Act in that it is a mark the adoption of which is prohibited by s. 9(1) of the Act, and specifically, the section 9 marks which have been adopted and used by the Vancouver 2010 Bid Corporation (formerly known as Vancouver Whistler 2010 Bid Corporation) as official marks for wares and/or services in respect of which the Registrar has given public notice of their adoption, the list of which appearing in Schedule B annexed to this decision (collectively referred to as “the Bid Corp. Official Marks”);
- 3) The Mark is not registrable pursuant to s. 12(1)(e) of the Act in that it is a mark the adoption of which is prohibited by s. 9(1) of the Act, and specifically, the section 9 marks which have been adopted and used by the Canadian Olympic Committee (formerly known as Canadian Olympic Association) as official marks for wares and/or services in respect of which the Registrar has given public notice of their

adoption, the list of which appearing in Schedule C annexed to this decision (collectively referred to as “the COC Official Marks”);

- 4) Contrary to s. 38(2)(a) and 30(b) of the Act the Applicant has not used the Mark since the date of first use claimed in the application, or at all, or had subsequently abandoned the Mark;
- 5) The Mark is not distinctive within the meaning of s. 2 of the Act because it is not capable of distinguishing the Applicant’s Wares and Services from the wares and services of others, particularly the wares and services sold by the Opponent under the Official Marks, the wares and services sold by the Vancouver 2010 Bid Corporation under the Bid Corp. Official Marks, or the wares and services sold by the Canadian Olympic Committee under the COC Official Marks, nor is it adapted to so distinguish them.

III General Principles Governing the Grounds of Opposition

[6] The legal burden is upon the Applicant to show that its application complies with the provisions of the Act, but there is however an initial evidential onus on the Opponent to establish the facts relied upon by it in support of each ground of opposition. Once this initial burden is met, the Applicant still has to prove, on a balance of probabilities, that the particular grounds of opposition should not prevent the registration of the Mark [see *Joseph E. Seagram & Sons Ltd. et al v. Seagram Real Estate Ltd.*, 3 C.P.R. (3d) 325, at pp. 329-330; *John Labatt Ltd. v. Molson Companies Ltd.*, 30 C.P.R. (3d) 293 and *Wrangler Apparel Corp. v. The Timberland Company*, [2005] F.C. 722].

[7] The relevant date varies from one ground of opposition to another. They are for:

- Registrability of the Mark under s. 12(1)(e) of the Act: the date of the Registrar’s decision. [See *Allied Corp. v. Canadian Olympic Association* (1989), 28 C.P.R. (3d) 161(F.C.A.) and *Olympus Optical Co. v. Canadian Olympic Association* (1991), 38 C.P.R. (3d) 1 (F.C.A.)];
- Distinctiveness of the Mark: the filing date of the statement of opposition is generally accepted as the relevant date (May 4, 2006). [See *Andres Wines Ltd. and E & J Gallo Winery* (1975), 25 C.P.R. (2d) 126 at 130 (F.C.A.) and *Metro-Goldwyn-Mayer Inc. v. Stargate Connections Inc.* (2004), 34 C.P.R. (4th) 317 (F.C.T.D.)]
- Compliance with the provisions of s. 30 of the Act: the filing date of the application (November 29, 2004)[see *Georgia-Pacific Corp. v. Scott Paper Ltd.*, 3 C.P.R. (3d) 469]

IV Compliance with s. 30 of the Act

[8] The Opponent has not introduced any evidence to support the fourth ground of opposition based on s. 30(b) of the Act. Moreover the Applicant's evidence does not raise any serious doubts on the statements contained in the application. The Opponent having failed to meet its initial onus this ground of opposition is dismissed.

V The Registrability of the Mark

[9] I shall now determine if the Opponent's first ground of opposition is well founded. As appears from the Opponent's official marks listed in Schedule A the best-case scenario for the Opponent is with its official mark TOURISM 2010, file number 917318 published on March 29, 2006.

[10] Ms. Byrne is the Opponent's Vice President and Corporate Secretary. She has filed copies of the Trade-marks Certificate, trade-mark register page and advertisement extracted from the Trade-marks Journal for each of the official marks listed in Schedules A, B and C including its official mark TOURISM 2010. As such the Opponent has met its initial onus with respect to the first three grounds of opposition.

[11] I wish to add that Ms. Byrne has filed an agreement signed by numerous parties and a copy of a memorandum prepared for the purpose of supporting the Opponent's request for advertisement of official marks. The status of the Opponent as a public authority and the ownership of the official marks have not been challenged by the Applicant in his counter statement or his evidence. Therefore I do not need to comment on these documents for the purpose of this decision.

[12] Mr. Bester filed as evidence a copy of what he has described "Eco-tourism 2010 name approval from the Government Agent Office in Prince George, B.C.". He filed a copy of a letter dated September 28, 2004 from the Vancouver Organizing Committee for the 2010

Olympic and Paralympic Winter Games (“VANOC”) to him. He also filed a copy of a print out of some unidentified database providing some information on the present application and the filing notice issued by the Registrar on November 29, 2004. He filed a copy of what has been identified as a “sworn statement by the Opponent’s agent in a provincial court proceeding”. He also filed a copy of an email sent by a third party with respect to the registration of three domain names that comprise the terms “eco” and “tourism” and the number 2010. Finally he filed a copy of what has been considered by the Registrar as the Applicant’s counter statement.

[13] I already commented on the counter statement and nothing further needs to be said. The content of the email filed constitutes inadmissible hearsay evidence. The document purported to have been filed by the Opponent’s agent in another court proceeding is not a sworn statement and does not assist me in the issues to be resolved hereinafter. As for the name approval, it is interesting to note that the document contains the following inscription: “Requires consent of Vancouver Olympic Organizing Committee”. Finally the letter from the VANOC to the Applicant dated September 28, 2004 clearly states that: “VANOC is not in a position at this time to provide consent to the use of “2010” in the name of the Eco-Tourism Society.” All in all I do not consider the evidence filed by the Applicant to be of any assistance in the resolution of the issues to be described hereinafter.

[14] Section 9 (1)(n)(iii) of the Act reads:

9. (1) No person shall adopt in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for:

(...)

(n) any badge, crest, emblem or mark

(...)

iii) adopted and used by any public authority, in Canada as an official mark for wares or services,

in respect of which the Registrar has, at the request of Her Majesty or of the university or public authority, as the case may be, given public notice of its adoption and use;

[15] The Mark does not consist of the Opponent's official mark TOURISM 2010. The next issue to be resolved is if the Mark so nearly resembles as to be likely mistaken for TOURISM 2010? In *Canadian Council of Professional Engineers v. APA- The Engineered Wood Assn.* (2000), 7 C.P.R. (4th) 239 Mr. Justice O'Keefe defined the resemblance test under s. 9(1)(n) in the following terms:

[69] Having outlined the protection official marks enjoy, based on the provisions of the Act, it must be determined what the scope of prohibited marks is: the meaning of "consists of" most specifically. As a result of the foregoing, which clearly shows the privileged position official marks enjoy, I reject the interpretation of subparagraph 9(1)(n)(iii) proffered by the appellant and declare that the interpretation advanced by the Registrar is correct. In order to offend subparagraph 9(1)(n) (iii) so as to be unregistrable under paragraph 12(1)(e), the proposed mark must either be identical to the official mark or so nearly resemble it so as to be likely to be mistaken for it. The words "consists of" in the subsection of the Act are to be interpreted to mean "identical to" as was apparently held by the Registrar.

[70] This interpretation maintains the great ambit of protection afforded to official marks, but stops short of conferring an absurdly great ambit of protection for official marks which Parliament cannot reasonably be taken to have contemplated. It is inconceivable that Parliament intended to give such wide ambit of protection to official marks through the enactment of section 9 of the Act. Were the proposition of the appellant correct and any mark that contained, in some form, the official mark could not subsequently be adopted and would be unregistrable, it would be the case that the use of "ING" would be prohibited. Consider that no one could use the term "shopping.com", or any other mark ending in "ING", followed by ".com". It is not reasonable to state that such marks are prohibited. Such is a logical extension of the appellant's argument and results in an unreasonably vast monopoly and scope of protection. Such is not the intent of the protection for official marks.

[71] The interpretation I have adopted allows the wide ambit of protection to official marks which I believe is consistent with the scheme of the Act as a whole, related sections of the Act, as well as the intention of Parliament. No one may register or use a trade-mark "ENGINEER" (or another of the official marks) in association with any ware or service, notwithstanding the fact that such a possible trade-mark may not be confusing with the appellant's marks. And no one may register or use a trade-mark which is similar to the appellant's official marks so that it is likely to be mistaken for them, again notwithstanding that the mark may be sought to be used in association with such wares or services that it may well not be held to be "confusing" with the official marks as that term is used in section 6 of the Act. "Mistaken therefor" and "confusing with" are not synonymous.

[16] Furthermore, in *Canadian Olympic Association v. Cooperative Fédérée de Québec* (2000), 7 C.P.R. (4th) 309 Mr. Justice Lemieux stated:

(1) The test under section 9 is one of resemblance and where the official mark and the applied for mark are not identical, the issue "then is whether or not the Defendant's mark is almost the same as, or substantially similar to any or all of BSAO's marks" and that the relevant test to determine this question, as set out in the *R. v. Kruger* [(1978), 44 C.P.R. (2d) 135 (Reg. T.M.)], is whether "a person familiar with [BSAO's] marks [or any of them] but having an imperfect recollection thereof would... be likely to mistake the [Defendant's mark therefor]". (page 217)

[17] Consequently I shall not apply a straight comparison test. The only relevant factors are those listed in s. 6(5)(e) of the Act. The criteria under s. 6(5)(a) to (d) are not applicable. Therefore any difference in the wares and services sold by the parties in association with their respective trade-marks is not a relevant factor.

[18] I must determine if an average consumer, on a first impression, having an imperfect recollection of TOURISM 2010 would likely be mistaken in believing that the wares and services offered in association with the Mark come from the Opponent? My answer is affirmative. The only distinction is the prefix "eco". Notwithstanding the fact that "eco" is the first portion of the Mark, the dominant portions of the Mark are "tourism" and "2010". They constitute as a whole the Opponent's official mark. A consumer on a first impression of the Mark is likely to be mistaken and associate the Opponent as the source of the Wares and Services.

[19] I must point out that through the affidavit of Ms. Byrne the Opponent has introduced as evidence over thirty official marks it owns that comprise the number 2010. Because there was no oral hearing nor written argument I have to assume that the Opponent is relying on a family of trade-marks as a relevant factor. However there is no evidence of use of any of the official marks relied upon by the Opponent listed in its statement of opposition [see *Techniquip v. Canadian Olympic Assn.* (1999), 3 C.P.R. (4th) 298 (F.C.A.)]. Consequently the Opponent cannot rely on a family of trade-marks.

[20] Nevertheless I conclude that the Applicant has failed to discharge its burden to prove, on a balance of probabilities, that the Mark does not nearly resemble as to not be likely mistaken for the trade-mark TOURISM 2010. Accordingly the first ground of opposition is maintained.

[21] As for the second and third grounds of opposition, the only common feature between the official marks cited (see Schedules B and C annexed hereto) and the Mark is the number 2010. Applying the test of first impression and imperfect recollection described above I conclude that the Mark does not nearly resemble as to be likely mistaken with any of the aforesaid official marks. The addition of the terms “eco” and “tourism” to the number “2010” is sufficient to avoid any association in the mind of a consumer between the Mark and the official marks listed in those schedules. I wish to reiterate that the Opponent has not filed any evidence of use of these trade-marks and therefore cannot claim the benefit of a family of official marks comprising of the number 2010. Consequently those grounds of opposition are dismissed.

VI Distinctiveness

[22] The last ground of opposition is based on the alleged non-distinctiveness of the Mark in view of the Opponent’s official marks. Having concluded that the Mark is not registrable being a prohibited mark under s. 9(1)(n)(iii) under the first ground of opposition, it follows that the Mark cannot be distinctive nor was it adapted at the date of filing of the statement of opposition to distinguish the Wares and Services [see *Canadian Olympic Assn. v. SmithKline Beecham Biologicals S.A.* (2002), 20 C.P.R. (4th) 552 (T.M.O.B.)]. The last ground of opposition is maintained.

VII Conclusion

[23] Having been delegated authority by the Registrar of Trade-marks by virtue of s. 63(3) of the Act, I refuse this application pursuant to s. 38(8) of the Act

DATED IN BOUCHERVILLE, QUEBEC, THIS 23rd DAY OF SEPTEMBER 2009.

Jean Carrière,
Member, Trade-marks Opposition Board